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SUPREME COURT, U.S.

No. 06–1605

IN THE

Supreme Court of the United States

RENO A & E,

Petitioner,

v.

EBERLE DESIGN, INC. AND
ELECTRONIC DEVICES, INC.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

RESPONDENTS' BRIEF IN OPPOSITION TO THE PETITION FOR CERTIORARI

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QUESTIONS PRESENTED

1. Whether the Federal Circuit correctly applied regional circuit law rather than its own law in holding that petitioner failed to make a timely pre-verdict motion for judgment as a matter of law (JMOL) under the version of Federal Rule of Civil Procedure 50(b) that was in effect at the time of trial but has since been superseded.

2. Whether application of Federal Circuit procedural law would have yielded a different outcome, given that (a) petitioner's pre-verdict JMOL motion would have been untimely under the existing standards in all circuits, (b) the district court reached the merits and found the evidence sufficient to support the jury's verdict that petitioner's patent claims were invalid, and (c) the Federal Circuit itself affirmed the district court's denial of a new trial on grounds that evidence supported the verdict.

PARTIES TO THE PROCEEDINGS AND RULE 29.6 STATEMENT

There are no parties to the proceedings other than those listed in the caption. Respondents Eberle Design, Inc. and Electronic Devices, Inc. have no parent corporations, and no publicly held company owns 10% or more of their stock.

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RESPONDENTS' BRIEF IN OPPOSITION TO THE PETITION FOR CERTIORARI

OPINIONS BELOW

The order of the district court (David G. Campbell, J.) denying petitioner Reno A & E's motions for JMOL and new trial is unreported. The order of the court of appeals (William C. Bryson, Arthur K. Gajarsa and Timothy B. Dyk, JJ.) affirming the jury verdict and judgment that Reno's patent claims were invalid is also unreported. The order of the court of appeals denying Reno's petitions for rehearing and rehearing *en banc* is likewise unreported.

JURISDICTION

The court of appeals entered judgment on January 23, 2007. Reno's petition for rehearing and rehearing *en banc* was denied on March 2, 2007. Reno filed a timely petition for certiorari on May 31, 2007. This Court has jurisdiction under 28 U.S.C. § 1254(1).

PERTINENT STATUTES AND RULES

Reno's patent claims were found invalid under 35 U.S.C. § 102(b), which provides, in relevant part:

> A person shall be entitled to a patent unless—
>
> * * *
>
> (b) the invention was * * * on sale in this country, more than one year prior

> to the date of the application for patent in the United States * * *.

Reno's preservation of its right to challenge the sufficiency of the evidence turns on the version of Federal Rule of Civil Procedure 50(b) that was in effect when trial concluded in September 2005, which provided, in relevant part:

> **(b) Renewing Motion for Judgment After Trial; Alternative Motion for New Trial.**
>
> If, for any reason, the court does not grant a motion for judgment as a matter of law made at the close of all the evidence, the court is considered to have submitted the action to the jury subject to the court's later deciding the legal questions raised by the motion. The movant may renew its request for judgment as a matter of law by filing a motion no later than 10 days after entry of judgment—and may alternatively request a new trial or join a motion for new trial under Rule 59. * * *

STATEMENT OF THE CASE

1. Inductive loop vehicle detectors determine the presence of vehicles at locations such as traffic intersections, parking garages and access gates. They typically operate in certain "function states" (operating modes) and at certain "parameter values" (e.g., loop frequencies and sensitivity settings). Reno's U.S. Patent No. 6,087,964, entitled "Vehicle Detector with Operational Display," purports to claim the incorporation of visual displays such as LCD screens into

ordinary vehicle detectors to show traditional detector function states and the identities and values of typical detector parameters.

Reno and respondent Eberle Design, Inc. compete in the market for traffic and access control devices. Respondent Electronic Devices, Inc. is a contract manufacturer for Eberle Design.

2. In October 2002, Reno filed a patent infringement action in the District of Nevada. Eberle filed a declaratory judgment action in the District of Arizona two months later. The Nevada district court transferred the Nevada action to the District of Arizona, where it was consolidated with Eberle's action.

At trial, Eberle and Electronic Devices primarily contended that Reno's patent claims were invalid and unenforceable. Among other things, respondents contended that the claims were invalid under the "on-sale bar" of 35 U.S.C. § 102(b). In particular, respondents contended that Reno and its founder and president, Thomas Potter, had offered products embodying the claimed invention for sale more than a year before Mr. Potter applied for his patent.

Under this Court's decision in *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55 (1998), the on-sale bar applies if two conditions were satisfied as of the critical date: (a) the invention had been the subject of a commercial offer for sale in this country, and (b) the invention was "ready for patenting" at the time, meaning that the inventor had conceived of the invention and could explain how to make and use it—regardless of whether the invention had been reduced to practice at the time and regardless of whether a product was then ready for shipment. *Pfaff*

also reaffirmed that a patent claim is equally invalid if the claimed invention was *obvious* in light of a product on sale before the critical date.

In this case, the jury unanimously found the asserted claims invalid because Reno had made a commercial offer to sell a product embodying the claimed invention more than two months before the critical date, at a time when the invention was ready for patenting. The evidence supporting that finding came from Reno's contemporaneous business records and the admissions of its president, Mr. Potter. In particular, the evidence showed that in February 1996, Mr. Potter responded to an order by a customer for old-style detectors by counteroffering to supply 200 new-style detectors with LCD displays, with delivery that summer. The jury did not believe Mr. Potter's excuse that the counteroffer was "ceremonial" rather than serious. The jury also rejected Mr. Potter's contention that the conceptually simple invention was not "ready for patenting" merely because additional features had to be perfected before a commercial product was ready for shipment.

3. Reno failed to move for JMOL at the close of all the evidence, as necessary to preserve its right to challenge the sufficiency of the evidence under the version of Federal Rule of Civil Procedure 50(b) then in effect.

Reno did move for JMOL at the close of respondents' case-in-chief, but the district court denied that motion during trial, finding that the facts were disputed and that the credibility calls were for the jury. The court specifically observed that "[o]bviously, Reno is free to make motions again at any point it deems appropriate in the trial." [Fed. Cir. Jt. App.

2691] Despite that invitation, Reno chose *not* to renew its JMOL motion at the close of all the evidence.

4. After the district court entered judgment on the verdict, Reno attempted to attack that judgment by renewing the motion for JMOL it had made at the close of respondents' case-in-chief. Reno also moved for a new trial on several grounds, including an allegation that the jury's verdict was contrary to the evidence. For their part, respondents countered that Reno had waived its right to challenge the sufficiency of the evidence and urged that the evidence amply supported the on-sale bar verdict in any event.

The district court upheld the verdict. Among other things, it concluded that "Reno is not entitled to JMOL on the issue of invalidity because Eberle presented evidence from which a reasonable jury could conclude that the requirements of the on-sale bar were satisfied by clear and convincing evidence." [Pet. App. 5a] It further held that "Reno is not entitled to a new trial because * * * the jury's verdict was not against the weight of the evidence or seriously erroneous * * *." [Pet. App. 5a–6a] Given those conclusions, the court declined to "decide whether Reno was entitled to seek a post-trial JMOL under Rule 50(b) * * *." [Pet. App. 6a]

5. Reno appealed, but the Federal Circuit affirmed the judgment in a short, unanimous, unpublished order that issued shortly after oral argument.

As a threshold matter, the Federal Circuit held that "Reno A & E did not move for judgment as a matter of law at the close of all the evidence and thus failed, under then-applicable principles of Ninth Circuit law, to preserve its right to challenge the

sufficiency of the evidence." [Pet. App. 3a (citing *Janes v. Wal-Mart Stores, Inc.*, 279 F.3d 883, 886–87 (9th Cir. 2002))] It further held that "[a]lthough Reno timely moved for a new trial, the district court did not abuse its discretion in denying that motion * * * because Reno has failed to show that the record contains no evidence to support the verdict." [Pet. App. 4a (citing *Landes Constr. Co. v. Royal Bank of Can.*, 833 F.2d 1365, 1372 (9th Cir. 1987))]

6. After the panel's judgment issued, Reno petitioned for rehearing and rehearing *en banc*, arguing that Federal Circuit law rather than Ninth Circuit law should govern whether it preserved its right to challenge the sufficiency of the evidence supporting the jury's verdict. Reno had never made that argument previously, nor had it suggested that *Biodex Corp. v. Loredan Biomedical, Inc.*, 946 F.2d 850 (Fed. Cir. 1991), or *Duro-Last, Inc. v. Custom Seal, Inc.*, 321 F.3d 1098 (Fed. Cir. 2003), required application of Federal Circuit procedural law. Instead, Reno had merely urged that the Ninth and other circuits had construed Rule 50(b) "flexibly" and "liberally" and excused failures to move for JMOL at the close of all the evidence.[1]

The Federal Circuit denied the petition without calling for a response and without dissent. [Pet. App. 1a–2a]

This petition for certiorari followed.

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[1] Reno did cite *Biodex* in its briefs, but only in connection with its argument (not pressed here) that the district court prejudicially erred in omitting one word in a jury instruction. Reno did not cite *Duro-Last* at all.

SUMMARY OF ARGUMENT

Reno identifies no conflict in Federal Circuit law, much less a conflict between Federal Circuit law and a decision of this Court or another circuit that could justify certiorari. The Federal Circuit has consistently applied the law of the regional circuits to procedural questions that do not implicate substantive patent law and do not involve the court's own jurisdiction or internal administration. In particular, it consistently held that regional circuit law governs whether a party's failure to move for JMOL at the close of all the evidence pursuant to Rule 50(a) precludes it from seeking JMOL after judgment under Rule 50(b). Reno cites no case to the contrary.

The decision below also raises no important issue meriting certiorari. To begin with, the memorandum decision was unpublished and therefore nonprecedential. Furthermore, although the circuits had adopted slightly different standards in evaluating waiver of the right to move for JMOL under Rule 50(b), the law going forward will be uniform. Effective December 1, 2006, Rule 50(b) has been amended to eliminate the requirement of moving for JMOL at the close of all the evidence.

In any event, even if the issue Reno raises were worthy of review, this case is a poor vehicle to decide it because the outcome here would be the same even if the Federal Circuit had applied its own law in construing Rule 50(b). Reno waived its right to challenge the sufficiency of the evidence even under the most liberal standard followed by any circuit under old Rule 50(b). Moreover, both the district court (in deciding Reno's JMOL motion) and the court of appeals (in deciding Reno's nearly identical new trial

motion) found that the evidence supported the jury's verdict. Reno does not and could not contend that those case-specific factual findings warrant review.

Reno's petition should therefore be denied.

ARGUMENT

I. Intra-Circuit Conflict Does Not Warrant Review, and Reno Identifies No Significant Intra-Circuit Conflict in Any Event

Reno's argument is founded on two mistaken premises. The first is that intra-circuit conflicts warrant intervention by this Court, and the second is that an intra-circuit conflict actually exists here.

A. Certiorari Is Designed to Resolve *Inter*-Circuit Conflicts, Not *Intra*-Circuit Conflicts

The core of Reno's argument is that the Federal Circuit's decision conflicts with two other decisions of the same court. Reno ignores, however, that it is the province of each court of appeals to resolve any internal conflicts in its jurisprudence—typically through *en banc* proceedings. Grants of certiorari by this Court, in contrast, are designed to address conflicts between decisions of *different circuits* (or between a decision of a court of appeals and a decision of this Court or a state supreme court). S. Ct. R. 10.

Notably, Reno's petition for rehearing *en banc* below made essentially the same arguments that it now advances in its petition for certiorari. The Federal Circuit perceived no conflict in its precedents. That alone is reason to deny review.

B. The Federal Circuit Has Consistently Held that Regional Circuit Law Governs Procedural Issues that Are Not Unique to Patent Law and Do Not Involve Questions of the Court's Own Power or Internal Operations

Even if this Court were inclined to police intra-circuit conflicts, there is no such conflict here.

Since its inception, the Federal Circuit has consistently held that its own precedent should govern substantive patent law issues subject to its exclusive jurisdiction, but regional circuit law generally should apply to issues that are *not* unique to patent law, including most procedural issues. *See, e.g., Sulzer Textil A.G. v. Picanol N.V.*, 358 F.3d 1356, 1363 (Fed. Cir. 2004); *Midwest Indus., Inc. v. Karavan Trailers, Inc.*, 175 F.3d 1356, 1359–61 (Fed. Cir. 1999) (*en banc* in relevant part); *Atari, Inc. v. JS & A Group, Inc.*, 747 F.2d 1422, 1440 (Fed. Cir. 1984) (*en banc*); *Panduit Corp. v. All States Plastic Mfg. Co.*, 744 F.2d 1564, 1574–75 (Fed. Cir. 1984).

The Federal Circuit wisely applies regional circuit law to non-patent issues because otherwise district courts and litigants would be forced to select between two potentially divergent lines of authority in the many cases involving both patent and non-patent issues. The Federal Circuit's approach also discourages forum-shopping by parties who could add or omit patent claims depending on whether they want Federal Circuit or regional circuit law to apply. *See, e.g., Midwest Industries,* 175 F.3d at 1359; *Atari,* 747 F.2d at 1439; *Panduit,* 744 F.2d at 1574–75.

Of course, choice-of-law guidelines are not always simple to apply in practice. Some issues, while nominally procedural or based on non-patent law, turn on or are inextricably intertwined with questions of patent law. Thus, for example, the Federal Circuit has held that its own law governs the relevance of materials in a patent case, *Truswal Sys. Corp. v. Hydro-Air Eng'g, Inc.*, 813 F.2d 1207, 1212 (Fed. Cir. 1987); which party has "prevailed" in a patent case, *Manildra Milling Corp. v. Ogilvie Mills, Inc.*, 76 F.3d 1178, 1182 (Fed. Cir. 1996); and whether patent law preempts claims under other statutes, *Midwest Industries*, 175 F.3d at 1360–61. Moreover, the Federal Circuit naturally applies its own law to questions involving its own procedural rules and its own power and jurisdiction as a court of appeals. *See Biodex*, 946 F.2d at 858.

The Federal Circuit's overarching choice-of-law principle, however, is uncontroversial and easily applied in most cases, including this one. The Federal Circuit has consistently held that the law of the regional circuit from which a case arises governs its scope of review of rulings on motions for JMOL and new trials. In particular, the Federal Circuit has repeatedly held that regional circuit law governs whether a party has waived its right to challenge the sufficiency of the evidence underlying a jury verdict by failing to make a timely JMOL motion under Rule 50(a). Those holdings have appeared in four published opinions and at least three unpublished ones:

- *Zodiac Pool Care, Inc. v. Hoffinger Indus., Inc.*, 206 F.3d 1408, 1416–17 (Fed. Cir. 2000) (applying Eleventh Circuit law and concluding that Hoffinger made a proper motion for

JMOL at the end of trial and thus preserved its right to renew that motion after trial);

- *Young Dental Mfg. Co. v. Q3 Special Prods., Inc.*, 112 F.3d 1137, 1141–42 (Fed. Cir. 1997) (applying Eighth Circuit law and holding that failure to move for JMOL at the close of all evidence barred any challenge to the sufficiency of the evidence via a "renewed" motion for JMOL or on appeal);
- *Delta-X Corp. v. Baker Hughes Prod. Tools, Inc.*, 984 F.2d 410, 412-13 (Fed. Cir. 1993) (applying Fifth Circuit law to determine the import of Baker's failure to move for directed verdict and concluding that Baker waived its right to move for JNOV);
- *Jurgens v. McKasy*, 927 F.2d 1552, 1557 (Fed. Cir. 1991) (citing Eighth Circuit law for the proposition that "[w]here a directed verdict motion is not made at the close of the evidence, the sufficiency of the evidence underlying presumed jury findings cannot be challenged through a JNOV motion or on appeal");
- *Atmel Corp. v. Silicon Storage Tech., Inc.*, 76 Fed. Appx. 298, 306, 311 (Fed. Cir. 2003) (applying Ninth Circuit law and concluding that SST's failure to move for JMOL at the close of all the evidence limited review to whether there was any evidence to support the verdict and whether plain error resulted in a manifest miscarriage of justice);
- *Bradford Co. v. Jefferson Smurfit Corp.*, 2001 WL 35738792, at *3–*4 (Fed. Cir. Oct. 31, 2001) (applying Sixth Circuit law and holding

that JSC waived its right to seek JMOL under Rule 50(b) by failing to move under Rule 50(a));

- *Cabinet Vision v. Cabnetware,* 230 F.3d 1382 (Fed. Cir. 2000) (Table) (available at 2000 WL 158463, at *4, *7–*8) (applying Ninth Circuit law based on parties' agreement that Ninth Circuit law applied, and concluding that failure to move for JMOL at the close of all the evidence barred Cabnetware from moving for JMOL under Rule 50(b)).

There is no intra-circuit split.

C. The Decision Below Is Fully Consistent with *Biodex* and *Duro-Last*

In an attempt to manufacture an intra-circuit conflict, Reno misreads the Federal Circuit's decisions in *Biodex Corp. v. Loredan Biomedical, Inc.,* and *Duro-Last, Inc. v. Custom Seal, Inc.* Properly read, *Biodex* and *Duro-Last* are fully consistent with the authority just cited.

1. *Biodex* addressed the Federal Circuit's authority to review absent a post-trial JMOL motion under Rule 50(b), not a litigant's waiver of the right to move for JMOL under Rule 50(b) by failing to make a proper predicate motion under Rule 50(a).

In *Biodex,* unlike this case, the plaintiff moved for a directed verdict under Rule 50(a) at the close of all the evidence. For some reason, however, Biodex did not renew that motion after the verdict. The question before the Federal Circuit was thus whether Biodex's failure to move under Rule 50(b) deprived it,

as an appellate court, of the authority to review the sufficiency of the evidence. 946 F.2d at 858–59.

The Federal Circuit noted its general practice of applying regional circuit law in construing the Federal Rules of Civil Procedure, *id.* at 857–58, but observed that the rationales for doing so were inapposite in that particular circumstance. In particular, because the issue was the *authority of the court of appeals,* the case raised no concern that a district court might be forced to apply two sets of rules:

> The extent to which the underlying factual findings of a judgment on a verdict are reviewed on appeal, absent a motion for JNOV, is an issue that can only arise after all the evidence is submitted and the verdict rendered. A district court would not, therefore, be required to have "served two masters" since the availability of appellate review is irrelevant to the conduct of the trial or to any decision on substantive legal issues that may arise during trial.

Id. at 859. The Federal Circuit went on to hold, as a matter of Federal Circuit law, that it could not review the sufficiency of the evidence underlying a jury verdict unless the appellant made a post-verdict motion for judgment under Rule 50(b). *Id.* at 859–62.

Since *Biodex* issued in 1991, the Federal Circuit has had no trouble distinguishing that case, which involved *its* authority as a court of appeals to review the sufficiency of the evidence absent any Rule 50(b) motion, from cases like this one, which involve a litigant's waiver of the right to move under Rule

50(b) by failing to move at the close of all the evidence under Rule 50(a). As discussed above, the Federal Circuit has consistently held that regional circuit law applies to the latter issue, which implicates district courts' power as well as appellate courts' authority.

In any event, *Biodex* has been superseded by an opinion of this Court that has effectively mooted its discussion of which circuit's law to apply. In *Unitherm Food Systems, Inc. v. Swift-Eckrich, Inc.*, 546 U.S. 394 (2006), this Court held that a party's failure to renew a motion for JMOL after a verdict precludes appellate courts from considering the sufficiency of the evidence. This Court's ruling, of course, applies in all circuits and to all kinds of cases.

2. Reno also cites *Duro-Last,* but that case merely turned to substantive patent law to determine whether a patentee's pre-verdict and post-verdict JMOL motions were based on the same grounds.

During trial, Duro-Last had moved for JMOL on Custom Seal's inequitable conduct and on-sale bar defenses. After the jury returned a verdict that the patents were invalid on a different ground, obviousness, Duro-Last purported to move for JMOL that the evidence did not support that verdict. The Federal Circuit recognized that it normally defers to regional circuit law on procedural matters that do not implicate patent law, including most questions relating to Rule 50 motions. 321 F.3d at 1106. It observed, however, that the case before it "involve[d] the specific question of whether a pre-verdict motion directed to inequitable conduct and the on-sale bar is sufficient to preserve the right to a post-verdict JMOL motion directed to obviousness." *Id.* "Because

that precise issue pertain[ed] uniquely to patent law, [the Federal Circuit] review[ed] the district court's determination under Federal Circuit law." *Id.*

Contrary to Reno's suggestion, the Federal Circuit did *not* hold or even imply that Federal Circuit law governs the timeliness of a predicate motion under Rule 50(a). Rather, it noted that "there is no question that Duro-Last made a timely JMOL motion at the close of evidence" and the question instead was "whether that JMOL motion sufficiently raised the obviousness issue." *Id.* at 1107. Here the situation is the opposite: Reno's purported Rule 50(b) motion undisputedly raised the same issue as its Rule 50(a) motion. Instead, the question was whether Reno made a timely Rule 50(a) motion at the close of all the evidence. The latter question, the Federal Circuit has consistently held, does not implicate substantive patent law and therefore turns on the standards of regional circuit law.

II. This Case Raises No Important Legal Issue of Enduring Concern

Reno also errs in suggesting that this case raises a legal issue of ongoing importance. To begin with, the Federal Circuit's two-paragraph judgment order was unpublished and therefore nonprecedential. Moreover, even if the order had been published, the Federal Circuit's decision to apply regional circuit law in deciding the timeliness of a predicate motion under Rule 50(a) would have no lasting impact. The choice of regional circuit or Federal Circuit law matters only if circuit law varies, and the law will be uniform going forward due to a recent amendment to Rule 50(b).

When this case was tried, Rule 50(b) provided that a movant could renew a motion for judgment as a matter of law only if it had previously made that motion "at the close of all the evidence." As discussed below, the circuits varied somewhat in how strictly they enforced that requirement—in particular when a motion made *before* the close of evidence would be considered equivalent to a motion made *at* the close of evidence. The drafters of the Federal Rules of Civil Procedure resolved the issue going forward by rewriting Rule 50(b) in 2006 to allow renewal of a Rule 50(a) motion made "at any time before the case is submitted to the jury." The Advisory Committee Note explained why the change was desirable, but also why effecting it required an actual amendment to the text of the rule:

> This change responds to many decisions that have begun to move away from requiring a motion for judgment as a matter of law at the literal close of all the evidence. Although the requirement has been clearly established for several decades, lawyers continue to overlook it. The courts are slowly working away from the formal requirement. The amendment establishes the functional approach that courts have been unable to reach under the present rule and makes practice more consistent and predictable.

The amendment took effect (prospectively) on December 1, 2006.[2] The proper reading of *old* Rule

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[2] Reno has never suggested that the December 2006 amendment retroactively justified its failure to move for JMOL at the close of all the evidence as required by the rule in effect in

50(b) thus matters only for cases that were tried before then. The question presented here, moreover, is not which reading of old Rule 50(b) was correct, but which circuit's law the Federal Circuit should have consulted in deciding how to apply old Rule 50(b). That question is one step further removed and of even less ongoing significance.

III. The Outcome of This Case Would Be the Same Even If Federal Circuit Law Applied to the Waiver Issue

Even if this Court were inclined to decide the questions presented, this case is a poor vehicle for doing so because the outcome would be the same in any event. Reno waived its right to challenge the sufficiency of the evidence even under the most generous reading of old Rule 50(b), and on the merits—as both courts below found—the evidence amply supported the jury's verdict.

A. Reno Waived Its Right to Move for JMOL Even Under the Most Lax Standard in Effect in September 2005

Reno suggests that if the Federal Circuit had applied its own law, it would have found Reno's mid-trial motion for JMOL adequate to preserve its right to challenge the sufficiency of the evidence. In particular, Reno argues that (1) the Federal Circuit in *Duro-Last* adopted the Sixth Circuit's liberal view of

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September 2005. *See also Pro Football Weekly, Inc. v. Gannett Co.*, 988 F.2d 723, 725 (7th Cir. 1993) (applying pre-amendment version of Rule 50 where "proceedings below were concluded prior to the rule's amendment").

old Rule 50(b) in *Boynton v. TRW, Inc.*, 858 F.2d 1178, 1185–86 (1988) (*en banc*); and (2) under *Boynton*, any pre-verdict motion for JMOL can be a predicate for a post-trial motion for JMOL on the same grounds. Reno is wrong on both points.

To begin with, the Federal Circuit did not adopt *Boynton*. The portion of *Duro-Last* quoted by Reno comes from a paragraph describing Duro-Last's argument. *See* 321 F.3d at 1106 ("Duro-Last urges us to follow the approach some other circuits have taken, adopting a liberal view of what constitutes a sufficient predicate for a Rule 50(b) motion."). The Federal Circuit loosely described *Boynton*, but it then noted that *Boynton* was inapposite because "there is no question that Duro-Last made a timely JMOL motion at the close of evidence." 321 F.3d at 1107.

In any event, Reno waived its right to challenge the sufficiency of the evidence supporting the verdict even under *Boynton*. *Boynton* did not anticipatorily adopt new Rule 50(b). It simply excused a failure to move for directed verdict at the close of evidence on "unique facts" where the district court had taken an earlier directed verdict motion under advisement, "indicat[ing] its firm intent to 'get the case to the jury,'" and the defendant's subsequent case was brief and cumulative. 858 F.2d at 1185–86. Ninth Circuit law was similar. The Ninth Circuit too had found a pre-verdict JMOL motion adequate if it was made at the close of the opponent's case and *remained pending* at the close of all the evidence because the trial court had never ruled on it. *See, e.g., Herrington v. Sonoma County*, 834 F.2d 1488, 1500 (9th Cir. 1987).

The problem for Reno here was that the district court *expressly denied* Reno's motion for JMOL at the

close of respondents' case. Moreover, Reno's omission was not technical or trivial. This was a seven-day trial. Reno moved for JMOL in the middle of trial on Day 3. Its motion was denied at the outset of Day 5, and the evidence did not conclude until the end of Day 6. Reno introduced extensive evidence relating to the on-sale bar after it moved for JMOL at the close of respondents' case, and some of that evidence (including both documents and testimony) was admitted after the district court denied the motion. The district court specifically invited Reno to move again during the trial, yet Reno declined or neglected to do so. No court would have absolved Reno in those circumstances. The only way to do so would have been to rewrite Rule 50(b) altogether. While Congress eventually did rewrite Rule 50(b), the Federal Circuit had no authority to do so.

B. In Any Event, the Outcome Would Be the Same Because (as Both Courts Below Held) the Evidence Supported the Jury's Verdict of Patent Invalidity

Finally, even if Reno had preserved its right to challenge the sufficiency of the evidence, the result here would be the same.

The district court found it unnecessary to decide whether Reno preserved its right to file a Rule 50(b) JMOL motion. It went straight to the merits and readily found that sufficient evidence supported the jury's on-sale bar verdict. [Pet. App. 5a–6a]

The Federal Circuit was procedurally more precise and found that Reno waived its right to move under 50(b). But it did reach the merits of Reno's virtually identical new trial motion, and held that

Reno had failed to show that the record contained no evidence to support the verdict. [Pet. App. 3a–4a] Nominally, the standards are slightly different: in reviewing denials of JMOL motions the Ninth Circuit looks for "sufficient" evidence to support the verdict, whereas in reviewing denials of new trial motions it looks for "any" evidence supporting the verdict or "exceptional circumstances in which the evidence weighs heavily against the verdict." *See, e.g., Dixon v. Wallowa County,* 336 F.3d 1013, 1019 (9th Cir. 2003); *United States v. Chen,* 754 F.2d 817, 821 (9th Cir. 1985). The difference is largely semantic, however. There is no reason to think that the Federal Circuit would have granted Reno JMOL when it denied Reno's parallel motion for a new trial.

CONCLUSION

Reno's petition for a writ of certiorari should be denied.

Respectfully submitted,

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